UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,591	08/13/2001	Rei-Young Amos Wu	40002-10459	7907

7590 12/17/2001

The Quaker Oats Company
Mail Code 25-7
321 North Clark Stret
Chicago, IL 60610

EXAMINER
TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
1761	6

DATE MAILED: 12/17/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/928,591	Wu
Examiner	**Art Unit**
Lien Tran	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Aug 13, 2001*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1, 19, and 21-38* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 19, and 21-38* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

1. Claims 21-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 30 are vague and indefinite. Step b is confusing; it is not clear what applicant intends to claim. If the coating material is applied before the heat-sensitive food material, it is not seen how it is physically possible that the heat-sensitive food material is coated by the coating material.

In all relevant claims, the recitations of " said first edible, heat-sensitive food material" and " said second edible food coating material" do not have antecedent basis because claims 21 and 30 only recite " an edible heat sensitive food material" and " an edible food coating material". The claims do not recite first or second.

In claims 31-38, it is not clear how these claims further limit claim 30 when they are method claims and claim 30 is a product claim.

2. Claims 21-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 21-38, applicant claims that the heat-sensitive food material is applied to the preliminary coated hand-held food item in such a manner as to be coated by the edible food coating material. This limitation is not supported by the original disclosure. Page 13 of the specification discloses a

sticky coating can be applied to the hand-held food item before the edible, heat-sensitive food material is applied. The edible, heat-sensitive food material is then applied on top of the sticky coating which provides for improved adhesion. The specification does not disclose that the heat-sensitive food material is coated by the edible coating material. If the edible coating material is applied before the heat-sensitive food material, it is not seen how it is physically possible that the heat-sensitive food material is coated by the coating material.

3. Claims 21-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method in which a coating material is first applied to the hand-held food item and then a heat-sensitive food material is applied on tope of the coated hand-held food item, does not reasonably provide enablement for applying the heat-sensitive material to the coated hand-held food item in such a manner that the heat-sensitive material is coated by the coating material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to carry out the invention commensurate in scope with these claims.

The steps as recited in the claims do not teach one how to apply the heat-sensitive material in such manner that the heat-sensitive material is coated by a coating material. The claims recite that the coating material is first applied to the hand-held food item and then a heat sensitive material is applied to the coated hand-held food item. If the edible coating material is applied first, it is not seen how it is physically possible that the heat-sensitive food material is coated by the coating material. The specification as well as the claims do not each one how to apply the

heat-sensitive material such that it is coated by the first coating material which has already been applied.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,19 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Holtz et al (5372826).

Holtz et al disclose ready-to-eat cereal flakes having edible particulate matter attached thereto. The cereal flake can comprise any known cereal grain including oats, wheat, rice, corn etc... The particulate matter includes fruits, nuts, seeds, confectionery items such as cookies, candies (see col. 4 line 46 through col. 5. line 2). The vehicle for attaching the edible particle includes syrups or gel; such syrup comprises water, one or more sweetener and flavoring agents (see col. 6 lines 24-35). The flakes after coating with the syrup is dried at a temperature of 121 degree C to about 260 degree C for a period of from about .2 to about 15 minutes (see col. 11 line 66 through col. 12).

The reference meets the limitation of the above claims. The cereal flake is then hand-held food item, the edible particulate matter is the heat-sensitive food material and the syrup coating is the food coating material. The drying temperature and time fall within the range claimed. With

respect to the product-by-process claim, the determination of patentability of product-by-process claim is based on the product itself and not how it is made (see In re Thorpe 227 USPQ 964).

6. Claims 21-29 and 31-38 are free of prior art because there is no teaching of the steps of applying a first coating material onto a hand-held food item and then applying a heat-sensitive food material to the coated food item in such a manner as to be coated by the edible food coating. Also, there is no suggestion in Holt et al to apply the particulate and the coating to a single grain cake.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 19 and 30-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6303163. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent disclose a process for preparing a hand-held snack item. The difference reside in the specific snack item recited in the patent. However, it would have been obvious to choose the snack item to be grain cake, granola bar, cereal bar or

breakfast bar because these are well known hand-held snack item. The selection of specific snack item would have been an obvious matter of choice. As to the product-by-process claims, the process of the patent will obviously give the product as claimed in the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is (703) 308-1868. The examiner can normally be reached on Wed-Fri. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

December 13, 2001

Lien Tran

LIEN TRAN
PRIMARY EXAMINER
Group 1700